



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,186	02/25/2004	Hugh S. West JR.	14000.8.1.1	2078
22913	7590	05/28/2009		
Workman Nydegger 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111				
EXAMINER				
GEORGE, TARA R				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
05/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/786,186

**Applicant(s)**

WEST ET AL.

**Examiner**

TARA R. GEORGE

**Art Unit**

3733

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-41, 43 is/are allowed.
- 6) ☒ Claim(s) 29-34 and 42 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "said pair of upper suture retention recesses or protrusions" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim. It is also noted that the upper suture retention recesses or protrusions are referred to as a "plurality" in claim 29.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-34 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. (US 4712542) in view of Fallin (US 2004/0254593).

With respect to claim 29, Daniel teaches a device comprising: a body having a first surface that is oriented toward a graft tensioning device (e.g. figs. 3 and 9) when in use and second surface that is oriented toward a bone tunnel in a patient's leg when in

use, the body having a center and a perimeter (e.g. fig. 7 below); a plurality of attachment passages or recesses (98) in said body for releasably attaching said body to a graft tensioning device during use, each passage or recess being sized and positioned so as to slidably receive therein a corresponding post (86) of a graft tensioning device, each of said attachment passages or recesses being defined by a respective hollow post guide projecting from said second surface of said body (note that the curve of 98 extends to the first surface as it is not one-dimensional as shown in the enlargement of fig. 7, referred to as fig. 7a, below) so as to maintain space between a patient's leg and said second surface of said body when said suture separation and organization device is in use; and a passageway or recess passing through the center of said body through which an interference screw can be inserted between tensioned suture strands during joint repair surgery (fig. 7 below).

Daniel teaches the claimed invention except for a first plurality of upper suture retention recesses or protrusions disposed on an upper perimeter of said body and a second plurality of lower retention recesses or protrusions disposed on a lower perimeter of said body, said first and second pluralities of suture retention recesses or protrusions being adapted to retain a plurality of tensioned suture strands or groups of tensioned suture strands extending away from a bone tunnel in a desired spaced-apart relationship on either side of the bone tunnel in order to facilitate insertion of an interference screw between the tensioned suture strands.

Fallin teaches a device used to organize sutures with line retention recesses or protrusions disposed on an upper and lower perimeter (e.g. at 140, 140' and 122 and 122'- fig. 9) in order to organize maintain the desired tension of sutures.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device used to hold the graft tensioning device of Daniel to include the upper and lower suture retention recesses in view of Fallin in order to provide one device that is used to organize the sutures while maintaining the desired tension and hold the graft tensioning device.

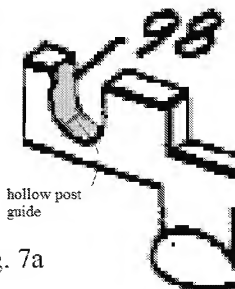
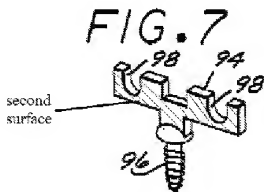


Fig. 7a

As for claim 30, Daniel further teaches said first surface of said body being substantially flat (fig. 7).

As for claim 31, Daniel further teaches wherein each respective hollow post guide projects orthogonally from said second surface of said body (fig. 7).

As for claim 33, Daniel further teaches a tensioning system for use in joint repair surgery, comprising: a suture separation and organization device according to claim 29; and a graft tensioning device configured so as to apply a desired tensile load to one or more soft tissue grafts emerging from a bone tunnel in a patient's limb and attached to a plurality of suture strands that extend away from the bone tunnel (see claim 29), said graft tensioning device including a plurality of posts designed so as to be slidably receivable through said attachment passages or recesses in said body (as stated in claim 29).

As for claim 34, Daniel further teaches a tensioning system for use in joint repair surgery according to claim 32, said graft tensioning device having adjustable tensioning means for selectively varying a tensile load applied to a plurality of suture strands attached to a soft tissue graft positioned within a bone tunnel and that extend away from the bone tunnel (abstract and claim 29).

As for claim 42, Daniel does not appear to teach the passageway or recess passing through the center of the body being substantially cylindrical. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the passageway or recess being substantially cylindrical, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a passageway or recess. In re Dailey and Eilers, 149 USPQ 47 (1966).

### ***Allowable Subject Matter***

Claims 35-41 and 43 are allowed.

Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Fallin is drawn to a device used hold surgical lines during arthroscopic procedures (para. 3) including sutures (para. 39).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARA R. GEORGE whose telephone number is (571)272-3402. The examiner can normally be reached on M-F from 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. R. G./  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733